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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/927,940 | 08/10/2001 | Arun Prasad | JPP-1260A NP | 6062 |

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04/04/2003

JENERIC/PENTRON, INC.
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EXAMINER

WESSMAN, ANDREW E

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 04/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,940

Applicant(s)

PRASAD, ARUN

Examiner

Andrew E Wessman

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-10 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-3, 5-10, and 12-15 remain for examination. Claims 1 and 9 have been amended. Claims 4 and 11 have been cancelled.
2. The rejection under 35 U.S.C. 112, 2nd paragraph has been withdrawn in view of the amendment to the claims.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 26, 2002 has been entered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prasad et al.

Prasad et al. is applied to the claims for the reasons set forth in paper No. 8, paragraph 5.

With regards to the amended feature of claim 1, wherein the coefficient of thermal expansion is about 16 to $18 \times 10^{-6} / ^\circ\text{C}$, because the claimed composition of the alloy overlaps the composition of the prior art alloys, within the overlapping range, the properties of the Prasad et al. alloy would be expected to be substantially the same as claimed. Furthermore, Prasad et al. states (col. 5, lines 5-6, also mentioned in applicant's remarks) that the coefficient of thermal expansion for that alloy is about 13 to about $15 \times 10^{-6} / ^\circ\text{C}$, and the upper range of that value of about $15 \times 10^{-6} / ^\circ\text{C}$ is not patentably distinct from "about $16 \times 10^{-6} / ^\circ\text{C}$ " as claimed. Therefore, a prima facie case of obviousness exists. See MPEP 2144.05

6. Claims 9, 10, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prasad et al. in view of Chiaramonte.

Prasad et al. in view of Chiaramonte is applied to the claims for the reasons set forth in paper No. 8, paragraph 6.

With regards to the amended feature of claim 9, wherein the coefficient of thermal expansion is about 16 to $18 \times 10^{-6} / ^\circ\text{C}$, the examiner's position was stated in above paragraph 4.

Response to Arguments

7. Applicant's arguments filed January 27, 2003 have been fully considered but they are not persuasive. In the remarks, applicant argues:

(1) The alloys of the claimed invention and the prior art have different coefficients of thermal expansion; and

(2) Chiaramonte uses gold in the alloy for different reasons than the claimed invention.

With regards to applicant's argument (1), the coefficient of thermal expansion in the Prasad et al. reference is substantially similar to that of the claimed invention because applicant's claimed coefficient of thermal expansion of about $16 \times 10^{-6}/^{\circ}\text{C}$ is close to about $15 \times 10^{-6}/^{\circ}\text{C}$ of Prasad et al., and in the case where the composition and properties of the prior art and the claimed invention are close enough, a prima facie case of obviousness exists. See *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) Applicant has failed to show what the substantial difference is between the claimed invention and the prior art, or any unexpected result achievable with the claimed invention and not with the prior art that would render the claimed invention unobvious. In the absence of further evidence, the claimed invention and the prior art are considered to be substantially the same.

With regards to applicant's argument (2), it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972), In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990). See MPEP 2144. In this case, even though Chiaramonte teaches adding gold to the alloy for different reasons than the applicant, because Chiaramonte teaches a motivation for adding the gold in the same amounts applicant teaches, the combination is still proper even if the reasoning behind the addition is different.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew E Wessman whose telephone number is (703)305-3163. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703)308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

AEW
April 2, 2003


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700